

REMARKS

In the final Office action dated September 10, 2003, claims 34, 36, 38, 48, and 53 were rejected under the judicially created doctrine of obviousness-type double patenting. Claims 34, 38, 43, 48, 52, 53, 55, 60 and 61 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,709,224 ("Behl"). Claims 68, 72-74, 77, and 78 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,885,278 ("Fleischman"). Claims 34, 36, 38-40, 43, 48-50, 52, 53, 55, 60, 61, 65, 66, 83 and 84 were rejected under 35 U.S.C. 103(a) as being unpatentable over Behl in view of Fleischman. Claims 41, 42, 51, 67, and 79-82 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

By the present amendment, claims 34, 53 and 68 have been amended. Claims 34, 36, 38-43, 48-53, 55, 60-61, 65-68, 72-74, and 77-84 are pending and under consideration in the present application. Claims 35, 37, 44-47, 54, 56-59, 62-64, 69-71, 75, and 76 were withdrawn from consideration as being drawn to an unelected species. A Request for Continued Examination ("RCE") is being filed herewith. Applicant respectfully requests reconsideration of the present application.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 34, 36, 38, 48, and 53 were rejected under the judicially created doctrine of obviousness-type double patenting. Should these claims be found to be otherwise

allowable over prior art, Applicant will submit a terminal disclaimer to obviate this rejection.

SECTION 102 AND 103 REJECTIONS

Claims 34, 38, 43, 48, 49, 52, 53, 55, 60 and 61 were rejected under Section 102(e) as being anticipated by Behl, and claims 68, 72-74, 77, and 78 were rejected under Section 102(e) as being anticipated by Fleischman. Claims 34, 36, 38-40, 43, 48-50, 52, 53, 55, 60, 61, 65, 66, 83 and 84 were rejected under Section 103(a) as being unpatentable over Behl in view of Fleischman.

In order to more clearly describe the claimed invention, Applicant has amended claim 34 to recite that "the electrodes are spaced apart from one another by less than 180 degrees," and claim 53 to recite that the directional energy application apparatus delivers energy to "a circumferential portion of the vein and not the entire circumference of the vein." Applicant respectfully submits that neither Behl nor Fleischman disclose or suggest the claimed invention.

The Office action relied on Figs. 5-9c and col. 5, lines 28-52 (and in particular on Figures 4D and 6) in Behl to show a preferential shrinkage along a circumferential portion of the vein. Applicant respectfully disagrees and respectfully submits that reliance on these disclosures is misplaced.

Figure 4D in Behl shows a pair of opposed elements 24 that bow outwardly, but these opposed elements are not electrodes. See col. 7, line 24-37 of Behl. Instead, it is the guidewire tip 32 that acts as the active electrode (see col. 7, line 46-48 and col. 8, line

9-15), and that element is not shown in Fig. 4D. As for Figure 6, penetrating electrode members 70 are described as "bipolar" (see col. 8, lines 30-33 and 50-56) which would suggest that electrical energy is to travel from one bipolar electrode to the opposite bipolar electrode, located 180 degrees away, and does not appear to operate as a directional energy application device.

Applicant also respectfully submits that neither Behl nor Fleischman discloses an electrode configuration that would apply energy to a circumferential portion of the vein. With respect to the Section 103 rejection, as noted in the Office action, "Fleischman is moot to cause preferential shrinkage of a vein. Fleischman is directed to ablating myocardial tissue to interrupt potential electrical pathways in the heart (and restore normal function to the heart), whereas Behl is directed to occluding blood vessels (and prevent the blood vessels from functioning). No proper motivation has been provided for one of ordinary skill to combine the teachings of prior art directed to such different problems in the manner suggested by the Office action. For at least this reason as well, Applicant respectfully submits that the Section 103 rejection of the claims be withdrawn as well.

Applicant has amended claim 68 to incorporate subject matter from dependent claims 78 and 79. The Office action noted that claim 79 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Although not incorporating every limitation of the base claim and any intervening claims, Applicant respectfully submits that claim 68 is allowable.

Should the presently rejected claims be allowed over the prior art, then the Applicant also respectfully requests that the claims withdrawn from consideration as being drawn to an unelected species, be considered and allowed as well.

CONCLUSION

Applicant respectfully requests favorable reconsideration of the claims at an early date. If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

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